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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/501,526  | 07/16/2004  | Tsuyoshi Komuro      | T3736-9161US01      | 7145             |
| 62574   | 7590        | 03/17/2008           | EXAMINER            |                  |
| Jason H. Vick<br>Sheridan Ross, PC<br>Suite # 1200<br>1560 Broadway<br>Denver, CO 80202 |             |                      | UBER, NATHAN C      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 4143                |                  |
|   |             |                      | MAIL DATE           | DELIVERY MODE    |
|   |             |                      | 03/17/2008          | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/501,526 | <b>Applicant(s)</b><br>KOMURO ET AL. |  |
|                              | <b>Examiner</b><br>NATHAN C. UBER    | <b>Art Unit</b><br>4143              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 2,9,15 and 17-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>24 October 2006, 12 August 2005, 09 August 2004</u> .         | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the national stage entry filed on 16 July 2004.
2. Claims 1-20 are currently pending and have been examined.

### **Information Disclosure Statement**

3. The Information Disclosure Statement filed on 24 October 2006 has been considered, the Information Disclosure Statements filed on 12 August 2005 and 9 August 2004 were not considered. Copies of non-patent literature and foreign patent documents must be submitted with the IDS; document submissions must be in English or be accompanied by an English abstract or explanation of the document's relevance to the application. See 37 C.F.R. 1.98(a)(2)-(3). Initialed copies of the Form 1449 are enclosed herewith.

### **Drawings**

4. Figures 2, 3 and 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Objections**

5. Claims 2, 9 and 18-20 are objected to because of the following informalities: spelling and grammatical problems, for example: claim 2 is missing "to" between *computer* and *perform*; claim 9 reads *a end device...* and should read "an" *end device*. Appropriate correction is required.

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6. Claims 15 and 17 are objected to because they are improper dependent claims. The claims read *the device according to claim (2 and 6 respectively)*. Neither claim 2 nor claim 6 are claims for a device, both claims are directed to computer programs. Claims 15 and 17 must be cancelled, rewritten in proper dependent form or rewritten in independent form.
7. Claims 9 and 18-20 are objected to because they are improper dependent claims under 35 U.S.C. 112 4<sup>th</sup> paragraph. A proper dependent claim shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words it shall not conceivably be infringed by anything which would not also infringe the basic claim. (See MPEP 608.01(n)III) Here any computer or PDA may infringe claims 9 and 18-19 and not also infringe the claims from which they depend. The claims must be cancelled, or rewritten in independent form.
8. Claims 9 and 18-20 are objected to because they are in improper sequence. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim. A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n)IV.

#### **Claim Rejections - 35 USC § 101**

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
10. Claims 2 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The *computer program* of Claims 2 and 6 are not directed to a process, machine, manufacture, or composition of matter, or any improvement thereof. Replacing *computer program* with “a computer-executable program tangibly embodied on a computer readable medium” is a suggestion for how to bring this claim into compliance with 35 U.S.C. 101

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because “a computer-executable program tangibly embodied on a computer readable medium” is statutory subject matter.

11. Claim 10 is rejected under 35 U.S.C. 101 because the claim is directed to non-statutory subject matter. The *data* of Claim 10 is *per se* not a process, machine, manufacture, or composition of matter, or any improvement thereof. Replacing *data* with “a computer-executable program tangibly embodied on a computer readable medium” is a suggestion for how to bring this claim into compliance with 35 U.S.C. 101 because “a computer-executable program tangibly embodied on a computer readable medium” is statutory subject matter.

#### Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
14. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz et al. (U.S. 6,760,916).

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**Claims 1 and 2:**

Holtz, as shown, discloses the following limitations:

- *means for storing the content, wherein the content is correlated with a content portion indicator that indicates the content portion and an advertisement portion indicator that indicates the advertisement portion; and* (see at least column 19, lines 61-63),
- *means for distributing the content* (see at least column 25, line 23-26).

**Claims 3 and 15:**

Holtz, as shown, discloses the following limitations:

- *means for recording a distribution log at the time of execution of the distributing means, wherein the distribution log is correlated with the content portion indicator and the advertisement portion indicator* (see at least column 37, lines 19-22).

**Claims 4 and 11:**

Holtz, as shown, discloses the following limitations:

- *a central processing unit (CPU) of the content distribution device is to execute the procedures of* (see at least Figure 1),
- *storing the content, wherein the content is correlated with a content portion indicator that indicates the content portion and an advertisement portion indicator that indicates the advertisement portion* (see at least column 19, lines 61-63),
- *distributing the content; and* see at least column 25, line 23-26),
- *recording a distribution log at the time of execution of distributing the content, wherein the distribution log is correlated with the content portion indicator and the advertisement portion indicator* (see at least column 37, lines 19-22).

**Claims 7, 16 and 17:**

Holtz, as shown, discloses the following limitations:

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- *means for outputting a content portion distribution log to a content provider which provides the content portion upon receiving a request for distribution log data from the content provider, wherein the content portion distribution log is retrieved from the log recording means based on the content portion indicator; and (see at least column 44, lines 48-53),*
- *means for outputting an advertisement portion distribution log to an advertisement provider which provides the advertisement portion upon receiving a request for distribution log data from the advertisement provider, wherein the advertisement portion distribution log is retrieved from the log recording means based on the advertisement portion indicator (see at least column 44, lines 48-53).*

**Claims 5 and 6:**

Holtz, as shown, discloses the following limitations:

- *means for recording a distribution log at the time of execution of distributing the content, wherein the distribution log is correlated with the content portion indicator and the advertisement portion indicator (see at least column 37, lines 19-22).*

**Claims 8 and 12:**

Holtz, as shown, discloses the following limitations:

- *A content distribution log recording device for recording a distribution log of a content distributed across a network, wherein the content comprises a content portion and an advertisement portion and is correlated with a content portion indicator that indicates the content portion and an advertisement portion indicator that indicates the advertisement portion (see at least column 37, lines 19-22),*
- *a central processing unit (CPU) of the content distribution log recording device is to execute the procedures of (see at least Figure 1),*



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- *records a distribution log at the time of execution of distributing a content, wherein the distribution log is correlated with the content portion indicator and the advertisement portion indicator (see at least column 37, lines 19-22),*
- *outputs a content portion distribution log to a content provider which provides the content portion upon receiving a request for distribution log data from the content provider, wherein the content portion distribution log is retrieved from the recorded distribution log based on the content portion indicator; and (see at least column 44, lines 48-53),*
- *outputs advertisement portion distribution log to an advertisement provider which provides the advertisement portion upon receiving a request for distribution log data from the advertisement provider, wherein the advertisement portion distribution log is retrieved from the recorded distribution log based on the advertisement portion indicator (see at least column 44, lines 48-53).*

**Claims 9 and 18-20:**

Holtz, as shown, discloses the following limitations:

- *A end device for receiving the content distributed by the device according to claim 1 (see at least Figure 1, Item 120).*

**Claim 10:**

Holtz, as shown, discloses the following limitations:

- *A data for indicating a content comprising a content portion and an advertisement portion (see at least column 23, lines 55-58),*
- *the data comprises: a unit for recording a content portion indicator that indicates the content portion (see at least column 23, lines 58-59),*
- *a unit for recording an advertisement portion indicator that indicates the advertisement portion; and (see at least column 35, lines 31-33)*

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- *a unit for recording a content indicator, wherein the content indicator is correlated with the content portion indicator and the advertisement portion indicator (see at least column 24, lines 42-44).*

**Claim 13:**

Holtz, as shown, discloses the following limitations:

- *developing the content by incorporating an advertisement image for a product or a service into the promotional image (see at least column 28, line 49-56, “adding auxiliary information” such as advertisements).*

**Claim 14:**

Holtz, as shown, discloses the following limitations:

- *obtaining viewing logs; and (see at least column 37, lines 64-65),*
- *paying the compensation from an advertisement provider to a content provider on the basis of the viewing logs (see at least column 37, lines 19-22).*

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### **Conclusion**

15. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
17. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to **571-273-8300**.

18. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 4143

10 March 2008

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143